IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Andreas Schmidt et al.
Serial No.:	10/559,890
Date Filed:	December 6, 2005
Group Art Unit:	2458
Confirmation No.	2852
Examiner:	Rashid, Harunur
Title:	**METHOD FOR TRANSMITTING MESSAGES IN AN MMS-BASED COMMUNICATION SYSTEM**

MAIL STOP – APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
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APPEAL BRIEF

Further to the Notice of Appeal submitted on December 27, 2010, and the Final Office Action dated October 15, 2010, Appellants hereby submit this appeal brief according to § 41.37.

APPELLANT'S BRIEF (37 C.F.R. § 41.37)

This brief is submitted in support of Appellants' notice of appeal from the decision dated October 15, 2010 of the Examiner rejecting claims 29-58.

I.   REAL PARTY IN INTEREST

This application is currently owned by Siemens Aktiengesellschaft as indicated by an assignment recorded on April 14, 2010, in the Assignment Records of the United States Patent and Trademark Office at Reel 024231, Frame 0504.

II.   RELATED APPEALS AND INTERFERENCES

There are no known appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision regarding this appeal.

III.   STATUS OF CLAIMS

At the time of the Final Office Action mailed October 15, 2010, Claims 29-58 were pending in this Application, and Claims 1-28 were previously cancelled without prejudice or disclaimer. All pending Claims 29-58 were rejected in the Final Office Action. Appellants present Claims 29-58 for appeal. Appendix A shows all pending claims.

IV.   STATUS OF AMENDMENTS

No amendments have been filed subsequent to final rejection.

V.   SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 29 recites a method for transmitting messages in a communication network (KN), (*Originally submitted substitute specification, e.g., page 8, paragraph [0020] to page 10, paragraph [0022]*)

comprising:

transmitting a transmission message (MM1_submit.REQ) containing one or more user data objects (MMA) to a switching component (MRS; MRSA; MRSB) for forwarding to a

first telecommunication device (MFG2); (*Originally submitted substitute specification, e.g., page 11, paragraph [0026]*)

creating a plurality of variants (A, B, C) of the one or more user data objects (MMA) in the switching component (MRS; MRSA; MRSB) as a function of one or more parameters; (*Originally submitted substitute specification, e.g., page 13, paragraph [0028] to page 15, paragraph [0034]; page 18, paragraph [0050]; page 20, paragraph [0053]; and page 21, paragraph [0056]*)

and

transmitting a delivery request message (MM1_notification.REQ(s)) to the first telecommunication device (MFG2) informing the first telecommunication device (MFG2) of the availability of the plurality of variants (A, B, C) of the one or more user data objects (MMA) that have been created by the switching component (MRS; MRSA; MRSB) before transmitting the transmission message (MM1_retrieve.RES) to the first telecommunication device (MFG2). (*Originally submitted substitute specification, e.g., page 11, paragraph [0026], page 15, paragraph [0035] to page 18, paragraph [0047], and page 18, paragraph [0049] to page 25, paragraph [0061]*)

Independent Claim 56 recites a method for transmitting messages in a communication network (KN), (*Originally submitted substitute specification, e.g., page 8, paragraph [0020] to page 10, paragraph [0022]*)

comprising:

transmitting a transmission message (MM1_submit.REQ) containing one or more user data objects (MMA) to a switching component (MRS; MRSA; MRSB), wherein the switching component (MRS; MRSA; MRSB) is operable to forward the transmission message (MM1_submit.REQ) to a first telecommunication device (MFG2) selected from a plurality of different telecommunication devices; (*Originally submitted substitute specification, e.g., page 11, paragraph [0026]*)

creating a plurality of variants (A, B, C) of the one or more user data objects (MMA) in the switching component (MRS; MRSA; MRSB) as a function of one or more parameters, wherein the plurality of variants (A, B, C) includes an unaltered version (A) of the one or more user data objects (MMA); (*Originally submitted substitute specification, e.g., page 13, paragraph [0028] to page 15, paragraph [0034]; page 18, paragraph [0050]; page 20, paragraph [0053]; and page 21, paragraph [0056]*)

and

before transmitting the transmission message (MM1_retrieve.RES) to said first telecommunication device (MFG2), transmitting a delivery request message (MM1_notification.REQ(s)) to the first telecommunication device (MFG2) by the switching component (MRS; MRSA; MRSB) informing the first telecommunication device (MFG2) of the availability of all variants (A, B, C) of the one or more user data objects (MMA) that have been created by the switching component (MRS; MRSA; MRSB). (*Originally submitted substitute specification, e.g., page 11, paragraph [0026], page 15, paragraph [0035] to page 18, paragraph [0047], and page 18, paragraph [0049] to page 25, paragraph [0061]*)

Independent Claim 57 recites a system for transmitting messages in a communication network (KN), (*Originally submitted substitute specification, e.g., page 8, paragraph [0020] to page 10, paragraph [0022]*)

comprising:

a switching component (MRS; MRSA; MRSB) receiving a transmission message (MM1_submit.REQ) containing one or more user data objects (MMA) for forwarding to a first telecommunication device (MFG2); (*Originally submitted substitute specification, e.g., page 11, paragraph [0026]*)

wherein the switching component (MRS; MRSA; MRSB) is operable to create a plurality of variants (A, B, C) of the one or more user data objects (MMA) as a function of one or more parameters, wherein the plurality of variants (A, B, C) includes an unaltered version (A) of the one or more user data objects (MMA); (*Originally submitted substitute*

specification, e.g., page 13, paragraph [0028] to page 15, paragraph [0034]; page 18,
paragraph [0050]; page 20, paragraph [0053]; and page 21, paragraph [0056])

and

wherein the switching component (MRS; MRSA; MRSB) is further operable to transmit a delivery request message (MM1_notification.REQ(s)) to the first telecommunication device (MFG2) informing the first telecommunication device (MFG2) of the availability of the plurality of variants (A, B, C) of the one or more user data objects (MMA) before transmitting the transmission message (MM1_retrieve.RES) to the first telecommunication device (MFG2). *(Originally submitted substitute specification, e.g., page 11, paragraph [0026], page 15, paragraph [0035] to page 18, paragraph [0047], and page 18, paragraph [0049] to page 25, paragraph [0061])*

Independent Claim 58 recites a telecommunication device (MFG1; MFG2) for transmitting and receiving messages in a communication network (KN), *(Originally submitted substitute specification, e.g., page 8, paragraph [0020] to page 10, paragraph [0022])*

wherein the telecommunication device (MFG1; MFG2) is operable:

to receive a delivery request message (MM1_notification.REQ(s)) from a switching component (MRS; MRSA; MRSB), wherein the switching component (MRS; MRSA; MRSB) is operable to receive a transmission message (MM1_submit.REQ) containing one or more user data objects (MMA) for forwarding to the telecommunication device (MFG2), wherein the switching component (MRS; MRSA; MRSB) is furthermore operable to create a plurality of variants (A, B, C) of the one or more user data objects (MMA) as a function of one or more parameters, and to transmit the delivery request message (MM1_notification.REQ(s)) to the telecommunication device (MFG2) informing the telecommunication device (MFG2) of the availability of the plurality of variants (A, B, C) of the one or more user data objects (MMA) that have been created by the switching component (MRS; MRSA; MRSB) before transmitting the transmission message (MM1_retrieve.RES) to the first telecommunication device (MFG2), to select at least one of said variants (A, B, C),

and to receive a delivery message (MM1_retrieve.RES) containing the requested at least one variant (A, B, C) of the one or more user data objects (MMA) from the switching component (MRS; MRSA; MRSB). (*Originally submitted substitute specification, e.g., page 11, paragraph [0026], page 15, paragraph [0035] to page 18, paragraph [0047], and page 18, paragraph [0049] to page 25, paragraph [0061]*)

VI.   GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 29-31, 34-41, 45, and 56-58 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Mostafa* (U.S. 2003/0154300) in view of *Shinohara* (U.S. 2002/0132608).

Claims 32 and 33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Mostafa* and *Shinohara* as applied above claim, in view of *Kalra* (U.S. 5,953,506).

Claims 43 and 43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Mostafa* and *Shinohara* as applied above claim, in view of *Puskala* (U.S. 2002/0165024).

Claims 44 and 46-55 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Mostafa* and *Shinohara* as applied above claim, in view of *Prenzel* (U.S. 2003/0096598).

VII.   ARGUMENT

The Examiner erred in concluding that the independent claims 29, 56, 57, and 58 are unpatentable over *Mostafa* in view of *Shinohara*

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).   Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007).   Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.*   "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

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Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

The independent claims 29, 56, 57, and 58 are directed to methods and systems which in essence comprise that the switching components of a network create a plurality of variants of a received message, for example, a multi-media message. Then, the switching components inform an intended recipient about the availability of the different variants (formats) in which the multi-media message is available. The recipient then selects one of the variants and retrieves the selected variant from the switching components.

a. The Mostafa Reference

Mostafa discloses a multi-media messaging system in which a recipient is notified that a message is available for download. (*Mostafa*, paragraph [0002]) The recipient can then at his convenience request a download of the stored message. (*Id.*)

In comparison with the subject matter as defined in the independent claims, *Mostafa* fails to disclose that the network components provide for a plurality of variants of the multimedia message. Furthermore, as a consequence, *Mostafa* also fails to notify the recipient that a plurality of variants are available and therefore there exists no selection process by the recipient in which the recipient selects one of the offered variants for download.

The Examiner stated that *Mostafa* teaches to inform a recipient about the content of a multimedia message in paragraph [0002]. (Final Office Action, page 2, section 3.1) Applicant respectfully disagrees. Paragraph [0002] merely discloses that the recipient is notified about the availability of a multimedia message for download. *Mostafa* neither states nor suggests that anything else is necessary. Because *Mostafa* does not teach to provide for multiple variants of the multimedia message, it is not necessary or even possible to inform the recipient about the content of the multiple variants. In the detailed description, *Mostafa* states:

"*MMS relay B receives the MMS message, stores it in MMS server B, and then informs MMS user agent B of the arrival of the message using an MMS notification message 310 (MM1_notification.REQ in 3GPP TS 23.140).*"

(*Mostafa,* page 2, paragraph [0022]) No statement can be found in *Mostafa* that a recipient is informed about the content of the multimedia message.

b. The Shinohara reference

With respect to *Shinohara,* the Examiner stated *Shinohara* discloses to modify the data format of a multimedia message in paragraph [0064] which is allegedly equivalent to the claim limitation of creating variants of the multimedia message. (Final Office Action, page 3) Applicant respectfully disagrees.

Shinohara teaches to maintain a database that stores the capabilities of various mobile devices. (*Shinohara,* paragraph [0063]) *Shinohara* further teaches that if a receiving device is not capable of processing a specific data type, then the system automatically modifies the data type into a format that can be processed by the device. (*Id.*) Nothing else is disclosed by *Shinohara.*

Modifying the data format of a multimedia message, however, is <u>clearly not equivalent</u> to "*creating a plurality of variants of the one or more user data objects in the switching component*" as claimed. Creating variants allows a recipient to choose which version he would like to download whereas the *Shinohara* automatically transforms the message into a format that can be processed by the receiver. Thus, the recipient never has the possibility of selecting a different type of message. However, such a feature has a significant benefit. While *Shinohara* is merely concerned with processing capabilities of a device and therefore automatically transforms a message into a receivable message, other criteria are not considered by the system of *Shinohara.* According to the present independent claims, a recipient is presented with a choice of for example, variant A, variant B, and variant C of a multimedia message. While his receiving device might be able to process all three formats, he may decide to download the version with the smallest size. Reasons for this can be, for example, processing speed, transmission speed or capacity limitations of his device. It

is thus the recipient who decides which of the variants are to be downloaded and not the network components.

Moreover, *Shinohara* teaches to find a common denominator in a group of recipients. To this end, *Shinohara* teaches to maintain a database that includes information about the capabilities of each telecommunication device that is supposed to receive a specific multimedia message. (See, *Shinohara*, paragraph [0057]). The system according to *Shinohara* then checks the ability of all participating telecommunication devices and basically determines a common denominator. (See, *Shinohara*, paragraph [0064]). Then, if necessary the system modifies the multimedia message to a format that can be retrieved by all participants. (*Id.*) *Shinohara* therefore neither teaches nor suggests to create multiple variants of a user object let alone informing a recipient of the availability of multiple variants of such a user object.

For this reason, Applicant believes that a combination of *Mostafa* and *Shinohara* as proposed by the Examiner cannot render the present independent claims obvious. Applicants respectfully submit that the dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicants respectfully request reconsideration and allowance of all pending Claims.
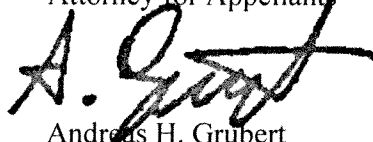
SUMMARY

Appellants respectfully request to reverse the decision of the Examiner rejecting claims 29-58 of the pending application.

Appellants authorize the Commissioner to charge $540.00 for the Appeal Brief to Deposit Account No. 50-4871 of King & Spalding L.L.P. However, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-4871 of King & Spalding L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Appellants' attorney at 512-457-2025.

Respectfully submitted,
KING & SPALDING LLP
Attorney for Appellants

Andreas H. Grubert
Registration No. 59,143

Date: February 7, 2011

SEND CORRESPONDENCE TO:
KING & SPALDING L.L.P.
CUSTOMER ACCOUNT NO. **86528**
512-457-2025
512-457-2100 (fax)

APPENDIX A - CLAIMS INVOLVED IN APPEAL

1-28.   (Cancelled)

29.   (Previously Presented)   A method for transmitting messages in a communication network, comprising:

transmitting a transmission message containing one or more user data objects to a switching component for forwarding to a first telecommunication device;

creating a plurality of variants of the one or more user data objects in the switching component as a function of one or more parameters; and

transmitting a delivery request message to the first telecommunication device informing the first telecommunication device of the availability of the plurality of variants of the one or more user data objects that have been created by the switching component before transmitting the transmission message to the first telecommunication device.

30.   (Previously Presented) The method according to claim 29, further comprising:

selecting a specific variant of the one or more user data objects and transmitting said selection from the first telecommunication device to the switching component; and

transmitting a delivery message containing the requested variant of the one or more user data objects from the switching component to the first telecommunication device.

31.   (Previously Presented) The method according to claim 29, wherein the step of informing the first telecommunication device comprises:

generating respective recipient notification messages assigned to a specific variant of the one or more user data objects; and

transmitting the respective recipient notification messages from the switching component to the first telecommunication device.

32.   (Previously Presented)   The method according to claim 29, wherein the parameters include parameters with information about the individual characteristics of the telecommunication device and in particular about applications provided on the telecommunication device.

33.   (Previously Presented)   The method according to claim 29, wherein the parameters include parameters with information about the individual preferences of the recipient.

34.   (Previously Presented)   The method according to claim 29, wherein the parameters include parameters with descriptive information, which includes the significance of user data objects contained in the transmission message and/or the relationships between contained user data objects.

35.   (Previously Presented)   The method according to claim 29, wherein the transmission message is transmitted from a second telecommunication device to the switching component.

36.   (Previously Presented)   The method according to claim 35, wherein the transmission message, delivery request message, delivery message, and recipient notification messages are transmitted in the context of the multimedia messaging service between the first telecommunication device and the switching component and/or the second telecommunication device and the switching component.

37.   (Previously Presented)   The method according to claim 35, wherein the messages to and from the first telecommunication device and/or the second telecommunication device are sent via an air interface.

38.   (Previously Presented)   The method according to claim 35, wherein the first and/or second telecommunication device comprises a radio module.

39. (Previously Presented) The method according to claim 35, wherein messages to and from the first and/or second telecommunication device are transmitted by means of the WAP protocol WSP and/or the hypertext transfer protocol.

40. (Previously Presented) The method according to claim 29, wherein the first telecommunication device is part of a first telecommunication network.

41. (Previously Presented) The method according to claim 40, wherein the first telecommunication network is configured as a mobile radio network, operating according to the GSM, GPRS, EDGE, UMTS, or CDMA standard.

42. (Previously Presented) The method to claim 40, wherein the switching component is configured as part of a second telecommunication network coupled to the first telecommunication network, which operates under the hypertext transfer protocol.

43. (Previously Presented) The method according to claim 42, wherein the first and second telecommunication networks are coupled together by a WAP gateway.

44. (Previously Presented) The method according to claim 31, wherein at least one of the recipient notification messages is transmitted to the telecommunication device by WAP push.

45. (Previously Presented) The method according to claim 29, wherein the switching component is configured as an MMS relay server.

46. (Previously Presented) The method according to claim 31, wherein the recipient notification messages, which are assigned to variants of user data objects of a specific transmission message, comprise specific standard identification information.

47.   (Previously Presented)   The method according to claim 46, wherein the recipient notification messages, which are assigned to variants of user data objects of a specific transmission message, further comprise total information, indicating the total number of recipient notification messages generated by the switching component for the variants of the one or more user data objects of a transmission message.

48.   (Previously Presented) The method according to claim 47, wherein different recipient notification messages have sequence information, which contains the sequence of the variants of the one or more user data objects generated by the switching component.

49.   (Previously Presented)   The method according to claim 31, wherein the different recipient notification messages have differentiation information, which indicates whether a variant of a user data object assigned to a respective recipient notification message is the original variant contained in the transmission message or a modified variant.

50.   (Previously Presented)   The method according to claim 48, wherein the sequence information in the different recipient notification messages indicates which of the recipient notification messages relates to the unmodified original version of the at least one user data object or the transmission message.

51.   (Previously Presented)   The method according to claim 48, wherein the identification information and/or the total information and/or the sequence information is provided under a respectively independent header field in a recipient notification message.

52.   (Previously Presented)   The method according to claim 48, wherein the identification information and/or the total information and/or the sequence information together is coded in a recipient notification message.

53. (Previously Presented) The method according to claim 48, wherein the identification information and/or the total information and/or the sequence information is processed by the first telecommunication device on receipt of a respective recipient notification message.

54. (Previously Presented) The method according to claim 52, wherein the variants for transmission by the switching component are displayed on a user interface so that a user can select one or more variants and request transmission by the switching component.

55. (Previously Presented) The method according to claim 53, wherein the user data objects contain text information, audio information, video information, executable programs, software modules or a combination of such information.

56. (Previously Presented) A method for transmitting messages in a communication network, comprising:

transmitting a transmission message containing one or more user data objects to a switching component, wherein the switching component is operable to forward the transmission message to a first telecommunication device selected from a plurality of different telecommunication devices;

creating a plurality of variants of the one or more user data objects in the switching component as a function of one or more parameters, wherein the plurality of variants includes an unaltered version of the one or more user data objects; and

before transmitting the transmission message to said first telecommunication device, transmitting a delivery request message to the first telecommunication device by the switching component informing the first telecommunication device of the availability of all variants of the one or more user data objects that have been created by the switching component.

57.   (Previously Presented)   A system for transmitting messages in a communication network, comprising:

a switching component receiving a transmission message containing one or more user data objects for forwarding to a first telecommunication device;

wherein the switching component is operable to create a plurality of variants of the one or more user data objects as a function of one or more parameters, wherein the plurality of variants includes an unaltered version of the one or more user data objects; and

wherein the switching component is further operable to transmit a delivery request message to the first telecommunication device informing the first telecommunication device of the availability of the plurality of variants of the one or more user data objects before transmitting the transmission message to the first telecommunication device.

58.   (Previously Presented)   A telecommunication device for transmitting and receiving messages in a communication network, wherein the telecommunication device is operable:

to receive a delivery request message from a switching component, wherein the switching component is operable to receive a transmission message containing one or more user data objects for forwarding to the telecommunication device, wherein the switching component is furthermore operable to create a plurality of variants of the one or more user data objects as a function of one or more parameters, and to transmit the delivery request message to the telecommunication device informing the telecommunication device of the availability of the plurality of variants of the one or more user data objects that have been created by the switching component before transmitting the transmission message to the first telecommunication device,

to select at least one of said variants, and

to receive a delivery message containing the requested at least one variant of the one or more user data objects from the switching component.

APPENDIX B - EVIDENCE

NONE

APPENDIX C: RELATED PROCEEDINGS

NONE